

10/608,862 Schneider et al.

RECEIVED
CENTRAL FAX CENTER
MAY 08 2007

Remarks

In the Office Action made Final, the Examiner objects to claims 16-17. Further, the Examiner rejects Applicants' claims 1-6, 8-13, and 16-22.

Applicants have amended claim 8 as set forth above to more clearly claim the invention. Applicants have canceled claims 16-20. Support for the amendments can be found in the originally filed specification and originally filed claims, specifically claim 1. No new matter has been introduced by the amendments. Applicants respectfully request entry of the foregoing amendments and reconsideration of the amended claims for the reasons set forth below.

10/608,862 Schneider et al.

RECEIVED
CENTRAL FAX CENTER

MAY 08 2007

The objections to claims 16-17

Applicants have canceled claims 16 and 17. Consequently, the Examiner's objections to claims 16 and 17 have been rendered moot.

10/608,862 Schneider et al.

The §102 rejections

With regard to claims 1-2, 8-9 and 13, the Examiner bases his rejection upon 35 USC §102(e) as anticipated by U.S. Patent No. 6,517,537, to Ein-Gal, (hereinafter referred to as "Ein-Gal"). As a result of Applicants' amendment of claim 8, and for the following reasons, Applicants respectfully submit that Ein-Gal is **not** proper grounds for rejection of the foregoing claims under 35 USC §102.

Ein-Gal does not anticipate each element of claims 1-2, 8-9 and 13.

A claim is anticipated under 35 USC §102 if each claimed element is found in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Applicants' claim 1 sets forth a method of manipulating an elongate member during a medical procedure. Within the method as set forth in claim 1, an elongate member having an axis along its length is claimed. Further, a motor is directed to rotate a base ***about the axis of the elongate member.***

Similarly, Applicants' currently amended apparatus claim 8 relates to a motor coupled to an elongate member and a base. The elongate member is rotated about the axis which substantially coincides with the longitudinal axis ***of the elongate member.***

Frame 22 disclosed by Ein-Gal does not rotate about the axis of an elongate member

Firstly, it is not clear to Applicants how frame 22 is able to rotate. Frame 22 is simultaneously "attached to a first positioner 36 that moves frame 22 in a first direction generally along [or about] longitudinal axis 38. . .[and] also preferably attached to a second positioner 40 that moves frame 22 in a second direction, such as generally along vertical axis 42. . ." Column 4:48-56. In Fig. 1B, frame 22 appears to be mounted upon, or at least supported from below by a base-like structure (unnumbered element behind numeral 14 and attached to positioner 40).

But more importantly, frame 22 is described by Ein-Gal to rotate ***about longitudinal axis 38.*** Longitudinal axis 38 of Fig. 1.B is illustrated as lying substantially below the plane in which stylets 12 lie. Longitudinal axis 38 does **not** coincide with the longitudinal axis of any of stylets 12. In fact, longitudinal axis 38 is increasingly distant from the longitudinal axes of

10/608,862 Schneider et al.

the stylets depending upon the position of a particular stylet 12 within frame 22. Consequently, frame 22 **does not rotate about the axis of any stylet** or elongate member either before or during a medical procedure. Rather, it is purported to rotate about a separate, somewhat distant axis.

In contrast, Applicants' method claim 1 clearly claims that the motor of Applicants' invention is directed to rotate the base *about the axis of the elongate member*. And in parallel, Applicants' apparatus claim 8 relates to an elongate member that is rotated about the longitudinal axis of the elongate member. Consequently, Ein-Gal does not disclose all of the elements of Applicants' claimed invention.

Further, Applicants respectfully submit that the rotation of the base of Applicants' invention *about the axis of the elongate member* is a significant advantage. As claimed by Applicants in independent claims 1 and 8, such rotation can occur *during a medical procedure*. Such rotation permits rotation of even the distal end of the elongate member, which may be rigid or semi-rigid. It would not be possible to rotate such a member while the member is positioned within the body if rotation was not about the axis of the member itself. In fact, it appears to Applicant that because Ein-Gal's frame 22 ostensibly rotates about an axis distant from the longitudinal axis of any stylet 12, a stylet 12 as disclosed by Ein-Gal could not be rotated via rotation of frame 22 once stylet 12 is placed within the body of a patient without injury to the patient. In contrast, Applicants' base and elongate member can be rotated at any point during, and indeed throughout, a medical procedure, when the elongate member is within the body of a patient.

Consequently, Applicants respectfully request that the rejection of claims 1-2, 8-9 and 13 be withdrawn.

Rejection of claims 16-20 have been rendered moot

Applicants have canceled claims 16-20. Consequently, the rejection of these claims under §102 has been rendered moot.

10/608,862 Schneider et al.

The §103 rejections

Ein-Gal in view of Beyar is not proper grounds for rejection of claims 4-6 and 10-12.

As set forth above in relation to claims 1-2, amended claim 8, claims 9 and 13, Ein-Gal does not disclose the elements of Applicants' invention. Claims 4-6 depend from independent claim 1. Claims 10-12 depend from independent claim 8. Moreover, neither Ein-Gal nor Beyar alone nor taken together teaches or suggests Applicants' invention. Consequently, Ein-Gal in view of Beyar is not proper grounds for rejection of claims 4-6 and 10-12 under 35 USC §103.

Applicants respectfully request that the rejection based upon §103 be withdrawn.